

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** TAURUS SYSTEMS, LLC

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Appeal No. 1999-1233  
Application 90/004,214<sup>1</sup>

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ON BRIEF

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Before THOMAS, FLEMING and HECKER, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

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<sup>1</sup> Request filed April 10, 1996, Control No. 90/004,214, by Taurus Systems, LLC for the Reexamination of Patent No. 5,065,360, issued November 12, 1991, based on Application 07/295,364, filed January 10, 1989.

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of claims 1 through 24, which are all of the pending claims in the above-identified reexamination of U.S. Patent No. 5,065,360 (hereafter referred to as the Kelly patent).

The claimed subject matter is directed to a device for inputting data from a remote location and for later transferring the data to a destination computer.

Independent claim 1 is reproduced as follows:

1. A portable data input, storage and editing device comprising:

input means for data entry;

storage means for storage of data entered by said input means;

transfer means for transferring data entered by said input means to a host computer;

processor means for controlling said input means, said storage means and said transfer means to operate in one of a plurality of modes, and

portable power storage means for operating at least said input means, said storage means and said processor means when said portable device is disconnected from the host computer thereby enabling remote input, storage and editing of said data entered by said input means,

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wherein the host computer comprises a keyboard interface, and

said transfer means comprises connecting means for connecting said device to said keyboard interface of the host computer and for transferring said data entered by said input means to the host computer via said keyboard interface.

The reference relied on by the Examiner is as follows:

A Journeyer's Guide to the Trine System, Trace Research and Development Center On Communication, Control and Computer Access for Handicapped Individuals, University of Wisconsin - Madison, 1985 (hereafter referred to as Trine)

Claims 1 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trine.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and the answer for the details thereof.

#### ***OPINION***

After a careful review of the evidence before us, we will sustain the Examiner's rejection of claims 1 through 24 under 35 U.S.C. § 103.

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At the outset, we note that Appellant has indicated on page 4 of the brief that claims 1 through 24 stand or fall together. We note that Appellant has only argued claim 1. 37 CFR § 1.192(c)(7) (July 1, 1995) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellant filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellant has stated that the claims stand or fall together and has not provided an explanation of why the claims are separately patentable. We will, thereby, consider the Appellant's claims as standing or falling together and we will

treat claim 1 as a representative claim of the group, claims 1 through 24.

***Scope of Appellant's Claim 1***

Appellant points out on page 6 of the brief that Appellant's claim 1 recites a "transfer means compris[ing] connecting means for connecting said device to said keyboard interface of the host computer and for transferring said data entered by said input means to the host computer via said keyboard interface." See brief, footnote 2. Appellant further points out that the above claimed language recited in Appellant's claim 1 incorporates the limitation that the portable input and storage device includes a keyboard emulator. Appellant further points out that the transfer means includes a connector cable for connecting the device to the keyboard interface of the host computer. Appellant states that the transfer means emulates the

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data input format of the keyboard. Appellant also argues that no additional external hardware is required to modify the data before the transfer of data through the keyboard interface of the host computer.

"[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). "Analysis begins with a key legal question--*what* is the invention *claimed*? . . . Claim interpretation . . . will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987).

Turning to Appellant's claim 1, we note that Appellant's claim does not require that the transfer means is to be housed in the same housing as the input means, storage means, and processor means. Thus, we find that Appellant's claim 1 does not preclude a portable data input, storage, and editing device

having an input means, a storage means, and a processor means as well as a portable power storage means all housed in one housing and a transfer means being housed in a second housing. Therefore, we find that the scope of Appellant's claim 1 does not recite any limitations how the portable data input, storage,

and editing device is housed, but only recites the components of the data input, storage, and editing device comprising an input means, a storage means, processor means, portable power storage means, and transfer means.

### ***Prima Facie Case***

On pages 21 through 28 of the brief, Appellant argues that the Kelly patent claims are not anticipated or obvious over Trine. Appellant argues that Trine teaches additional external hardware to emulate and transfer data through the keyboard interface of the host computer. Appellant argues that the primary technical advantage of the Kelly patent is its ability to connect a remote data entry

device directly to the keyboard interface of a destination computer.

On page 3 of the Examiner's answer, the Examiner has shown that Trine teaches all of the limitations recited in Appellant's claim 1. In particular, we note that the transfer means as recited in Appellant's claim 1 reads on the Epson HX-20 computer and the standard keyboard emulating interface as shown in the figure found in the "What Is It" section, subsection 7. On page 4 of the Examiner's answer, the Examiner points out that the claim does not require how the transfer means is to be housed.

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

Turning to Trine, we find that in the section "What Is It," subsection 7, Trine teaches a portable data input, storage, and editing device comprising an Epson HX-20 which



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includes an input means, a storage means, a processing means, and portable power storage means. Trine further teaches a portable data input, storage, and editing device that further includes a transfer means as recited in Appellant's claim 1 shown as a standard keyboard emulating interface. We find that Appellant's claimed portable data input, storage, and editing device reads on

Trine's teaching of the Epson HX-20 and the standard keyboard emulating interface together when viewed as a device. We appreciate Appellant's arguments that Trine does not teach a single housing. However, as discussed above, we find that Appellant's claim 1 does not recite such a limitation.

Upon reviewing the record, we find that the Examiner did make a ***prima facie*** case that Trine teaches all of the

limitations of Appellant's claim 1 and we thereby find Appellant's claim 1 is unpatentable over Trine under 35 U.S.C. § 103. Lack of novelty is the ultimate of obviousness. ***See In re Fracalossi***, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

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### ***Objective Evidence***

Appellant has provided secondary evidence which we must consider to reach a finding of obviousness within the stated rejection under 35 U.S.C. § 103. "[S]uch secondary considerations of nonobviousness as commercial success, long felt but unsolved needs, failures of others, and copying are considered in determining obviousness." ***Para-Ordnance Mfg. v. SGS Importers Int'l***, 73 F.3d 1085, 1087-88, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) ***citing Graham v. John Deere Co.***, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); ***Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.***, 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988). "It is jurisprudentially inappropriate to disregard any relevant evidence . . . . Thus, evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." ***Stratoflex Inc. v. Aeroquip Corp.***, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) ***citing In re Sernaker***, 702 F.2d 989, 996, 217 USPQ 1, 17 (Fed. Cir. 1983).

Appellant argues on page 13 of the brief that the Kothari declaration establishes the commercial success of the ALPHASMART keyboards, providing strong objective evidence that the Kelly patent is patentable. However, we fail to find that the Kothari declaration shows that the broad scope of claim 1 does require the transfer means to be housed within the same housing as the input means, storage means, processing means, and portable power storage means. In fact, the Kothari declaration establishes that, indeed, the commercial success is due to the fact that the transfer means is in the same housing as the above elements. It is well settled "that objective evidence or non-obviousness must be commensurate in scope with the claims which the evidence is offered to support." ***In re Grasselli***, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983) ***citing In re Tiffin***, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971).

On pages 14 through 17 of the brief, Appellant argues that the market acceptance and the laudatory response to the introduction of the ALPHASMART keyboard is more strong

evidence that the Kelly patent is patentable. However, our review of the

evidence provided by Appellant for the market acceptance and laudatory response fails to establish that the ALPHASMART keyboard is commensurate in scope with Appellant's claim 1. As we have pointed out above, the ALPHASMART keyboard is a keyboard which houses in a single housing all the elements of Appellant's claim 1. However, Appellant's claim 1 does not require a single housing and does not preclude more than one housing.

Similarly, Appellant argues on pages 18 through 21 further objective evidence establishing commercial acquiescence, long-felt need and copying. However, this objective evidence fails to establish for the reasons stated above that the ALPHASMART keyboard is commensurate in scope with Appellant's broad claim 1 which does not preclude more than one housing of the elements.

Therefore, we find that the evidence provided by the Appellant fails to provide sufficient objective evidence for

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us to find that the Examiner's *prima facie* case of obviousness should be overturned. Therefore, in view of the foregoing, we will sustain the decision of the Examiner rejecting claims 1 through 24 under 35 U.S.C. § 103. Accordingly, the decision of the Examiner is affirmed.

Further proceedings in this case may be taken in accordance with 35 U.S.C. §§ 141 to 145 and 306, and 37 CFR § 1.301 to 1.304. Note also 37 CFR § 1.197(b). If the patent owner fails to continue prosecution, the reexamination proceeding will be terminated, and a certificate under 35 U.S.C. § 307 and 37 CFR § 1.570 will be issued cancelling the patent claim(s), the rejection of which has been affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***AFFIRMED***

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	JAMES D. THOMAS	)	
	Administrative Patent Judge	)	
		)	
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		)	BOARD OF
PATENT			
	MICHAEL R. FLEMING	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES			
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	STUART N. HECKER	)	
	Administrative Patent Judge	)	

MRF:psb

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Paul E. Schaafsma  
Gardner, Carton & Douglas  
321 North Clark Street  
Suite 3400  
Chicago, IL 60610

Trace Research and Development Center  
1500 Highland Avenue  
Room S-151 Waisman Center  
Madison, WI 53705